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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,217	12/17/2004	Shigeru Suzuki	57965US006	7313

32692 7590 03/13/2006

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EXAMINER

NGUYEN, CHAU N

ART UNIT	PAPER NUMBER
2831	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/519,217	SUZUKI ET AL.	
	Examiner	Art Unit	
	Chau N. Nguyen	2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: in claim 1, line 7, "said hollow cylinder" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (WO 95/11542) in view of Dewdney (2002/0014349).

Nakamura et al. discloses a cold shrink tube unit comprising an elastic tube member (15) with an opening end and a hollow cylindrical slidingly detachable core member (Figures 3-4) removably provided inside a seal region of said elastic tube member, having a predetermined length from said opening end, to hold said seal region in an elastically expanded state, wherein said core member comprises a

body portion (31a) defining a hollow cylinder and a sliding portion (31b) integrally connected with one axial end of said body portion, said sliding portion having flexibility permitting it to be turned over and laid on an outer circumferential surface of said body portion, the sliding portion being formed adjacent to the body portion, and said slidably detachable core member being provided inside said seal region (re claims 1 and 8).

Nakamura et al. does not disclose said body portion (31a) including two or more plate-like sections capable of being combined with each other to form said hollow cylinder nor the sliding portion (31b) including two or more sliding sections. Dewdney discloses a core member (Figure 8) which is formed by two or more plate-like sections (the core member formed by the two sections 36, 37) capable of being combined with each other to form a hollow cylinder, a joint portion (38) pivotably connecting the plate-like portions with each other to form the hollow cylinder (re claim 3), and the joint portion being structured to deform under external force to allow the adjoining plate-like portions to be pivoted (re claim 4). It would have been obvious to one skilled in the art to modify the core member of Nakamura et al., including the body portion 31a and the sliding portion 31b, to comprise two or more adjoining sections as taught by Dewdney to avoid the need to unthread the core member from the free end of cable.

Re claims 9 and 10, the modified core member of Nakamura et al. discloses each individual sliding section being integrally connected with an axial end of each individual plate-like section.

3. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. in view of Osnami et al. (6,472,600).

Nakamura et al. discloses the invention substantially as claimed except for the body portion comprising two or more plate-like sections which comprise mutually independent parts and the sliding portion comprising two or more sliding sections, wherein the plate-like sections are provided with engagable end faces capable of being engage with each other in a form of said hollow cylinder, and which include reinforcing portions formed in peripheral end regions, including said engagable end faces, of said plate-like sections for holding said plate-like sections in a form of said hollow cylinder against an external force, and said reinforcing portions being formed in said engagable end faces, adapted to be engaged with each other, of said mutually adjoining plate-like sections, and respectively including concave and convex configurations detachably fitted with each other.

Osmani et al. discloses a core member (Figures 14 and 18) comprising two or more plate-like sections (the core member 4a formed by two plate-like sections

8 and 9) which comprise mutually independent parts, which are provided with engagable end faces capable of being engage with each other in a form of said hollow cylinder, and which include reinforcing portions formed in peripheral end regions, including said engagable end faces, of said plate-like sections for holding said plate-like sections in a form of said hollow cylinder against an external force, and said reinforcing portions being formed in said engagable end faces, adapted to be engaged with each other, of said mutually adjoining plate-like sections, and respectively including concave and convex configurations detachably fitted with each other. It would have been obvious to one skilled in the art to modify the core member of Nakamura et al., including the body portion 31a and the sliding portion 31b, to comprise adjoining plate-like sections as taught by Osmani et al. such that the core member can be removed from cable without pulling the core member through the free end of the cable.

Allowable Subject Matter

4. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that in regard to the amended claims, the examiner cannot establish a *prima facie* case of obviousness, it has been held that the examiner's burden of establishing *prima facie* case of obviousness is satisfied by a showing of structural similarity between the claims and prior art; it does not require a showing of some suggestion or expectation in the prior art that the structurally similar subject matter will have the same or similar utility as that discovered by the applicant. *In re Dillon*, 16 USPQ 2d 1897. Moreover, the fact that Nakamura et al., Dewdney and Osnami et al. are analogous art which is directed to core member being used in a shrinkable unit, the fact that the suggestion to combine the references are found the references themselves, see Dewdney and Osnami et al., the fact that there is a reasonable expectation in the combined references and the fact that the combined prior art references teach all claim features, see the rejection, it concludes that the *prima facie* of obviousness has established.

Summary

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Chau N Nguyen
Primary Examiner
Art Unit 2831